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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/925,740      | 08/10/2001  | Takuya Yamamoto      | 108384-00030        | 6658             |

7590

04/08/2003

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT

PAPER NUMBER

2826

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/925,740

Applicant(s)

YAMAMOTO

Examiner

Alexander O Williams

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2826

Serial Number: 09/925740    Attorney's Docket #: 108384-00030  
Filing Date: 8/10/01; claimed foreign priority to 8/25/00

Applicant: Yamamoto et al.

Examiner: Alexander Williams

Applicant's Response in Paper # 7, filed 1/17/03 has been acknowledged.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to claims 1 to 4, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether

claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims 1 to 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kashiba et al. (U.S. Patent # 5,153,077).

For example, in claim 1 and similar claims 2 to 4, Kashiba et al. **(figures 1 to 14c)** specifically **figure 1** show a copper clad laminate coated on both sides with copper foils of different thickness, wherein a first copper foil **2a** on one side of said laminate has the property of not being recrystallizable under the conditions that exists during a hot pressing step in the manufacturing of said laminate, and a second foil **2b** on the other side of said laminate that has the property of being recrystallizable under the conditions that exist during a hot pressing step in the manufacturing of said laminate and is thicker than said first foil (The Examiner is interested in finding the final structure claimed by Applicant. The conditions of the structure during manufacturing and step to get to the final structure are given little weight in examining the claims).

As to the grounds of rejection under section 103, see MPEP § 2113.

Claims 1 to 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maeda et al. (U.S. Patent # 4,751,146).

For example, in claim 1 and similar claims 2 to 4, Maeda et al. **(figures 1 to 17)** specifically **figure 11** show a copper clad laminate coated on both sides with copper foils of different thickness, wherein a first copper foil **1** on one side of said laminate has the property of not being recrystallizable under the conditions that exists during a hot pressing step in the manufacturing of said laminate, and a second foil **9** on the other side of said laminate that has the property of being recrystallizable under the conditions that exist during a hot pressing step in the manufacturing of said laminate and is thicker than said first foil. (The Examiner is interested in finding the final structure claimed by Applicant. The conditions of the structure during manufacturing and step to get to the final structure are given little weight in examining the claims).

As to the grounds of rejection under section 103, see MPEP § 2113.

## Response

Applicant's arguments filed 1/17/03 have been fully considered, but are moot in view of the modified grounds of rejections detailed above. Applicant's remarks on pages 3 to 11 have been considered, but are not found to be persuasive. Applicant's arguments under "II. The Claims Are Not "Product-by-Process" Claims" are not found to be persuasive. Applicant's arguments are moot in like that the claims does not claim properties with Young's modulus and its contradiction. Applicant's reference to recrystallization and hot pressing is given little weight. What define "hot" is the claim and specification. In order for the laminated coating to be recrystallized, it would have to reach a temperature high even to melt of laminate and when it began to cool be recrystallized. The Examiner is interested in finding the final structure claimed by Applicant. Kasoba et al., for example, show an alumina as the laminated coating on both sides of the copper clad. It's final structure show the features of Applicant's claim. Maeda et al.'s show the final structure claimed by Applicant also.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY

PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE  
OF THIS FINAL ACTION.

| Field of Search   | Date                          |
|---|-------------------------------|
| U.S. Class and subclass:<br>257/762,758,700,701                               | 4/18/02<br>10/15/02<br>4/3/03 |
| Other Documentation:<br>foreign patents and literature in 257/762,758,700,701 | 4/18/02<br>10/15/02<br>4/3/03 |
| Electronic data base(s):<br>U.S. Patents EAST                                 | 4/18/02<br>10/15/02<br>4/3/03 |

***Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.***

Any inquiry concerning this communication or any earlier communication from the examiner should be directed to **Examiner Alexander Williams** whose telephone number is **(703) 308-4863**.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 receptionist** whose telephone number is **(703) 308-0956**.

4/3/03



Primary Examiner  
Alexander O. Williams